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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JAMAL, ALEXANDER

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

07/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,496	Applicant(s) KOTZE ET AL.	
	Examiner ALEXANDER JAMAL	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Based upon the submitted amendment, the examiner notes that claim 4 is cancelled.
2. Based on applicant's assertion that indicating that telephone equipment is in working order as claimed, is different than the line/equipment verification of the cited prior art, The examiner presents a non-final 112 rejection to applicant's claims and drawings.
3. The examiner notes applicant's comments regarding the lightning protection indicator. The examiner also notes applicant's specification which describes that various components will become open/short circuited which will cause the LED to not be lit. In view of the specification, the examiner reads **any** circuit as **inherently comprising lightning protection**. If lightning strikes a device (such as the one disclosed by Fostveit), any component may be open circuited or shorted to ground, which will stop any indicators from working (since the circuit will no longer be functional). This is the **same** type of 'indication' of the lightning protection that is described in the specification.

Drawings

1. AThe drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the AC and DC circuits test signal injectors of **claims 8,10** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Art Unit: 2614

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-3,5-22** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2614

As per **claims 1-3,5-22**, in the remarks filed 3-30-2009, the applicant argues that there is a clear distinction between the line/equipment verification of the claimed device versus that disclosed by prior art patent to Fostveit. The examiner contends that based on applicant's arguments and what is actually disclosed in the specification, that applicant has not clearly defined what determines if the claimed equipment is 'in working order'.

As per **claims 1-3,5-22**, the claims recite that in the second position of the switch, the telecomm line is coupled to the equipment testing circuit (which is coupled to the equipment). It is not clear what test is being performed. How will current flow through the 'indicator' unless the phone (equipment) is offhook ? A normal on-hook phone will present an open circuit in DC and no current will flow. What test is applicant performing? The disclosed drawings do not show where any signals are injected, only connections made to equipment and loops and an LED 'indicator'. Again it is not clear how the disclosed circuit, when coupled in between a phone line and a phone equipment, will positively discern that the equipment is 'in working order'.

As per **claims 8,10**, the claims recite an AC and DC testing circuit, but these are not clearly shown in any of the drawings. It is not clear how the claimed AC and DC circuits couple to the claimed device, and further it is not clear exactly how they are used to discern that the equipment is 'in working order' (as the specification does not describe what 'working order' is defined as).

For the purpose of examination, the examiner gives the claimed term 'in working order' a reasonably broad reading, which would include the determination of equipment in working order disclosed by prior art patent to Fostviet.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-3,5-22** rejected under 35 U.S.C. 103(a) as being unpatentable over Fostveit (4513176) and further in view of Cwirzen (4875868).

As per **claims 1,15**, Fostveit discloses a floating telephone system tester with a switch with three positions. Two of the switch positions goto testing circuits ('equipment' and 'line'). The device couples to a network line (which may be coupled to network equipment) and performs a line test. If the line/equipment are in working order the LED's indicate as such (Fig. 2). However, Fostveit does not disclose lighting protection on the line/equipment tester.

Cwirzen discloses network terminals use lightning protection for protection. If lightning were to strike the device of Fostviet, then the circuitry components would be shorted/opened and the indicator would not function (would indicate that the lightning protection was there or not). It would have been obvious to one skilled in the art to provide lightning protection for any interfaces that could possibly be exposed to lightning (especially one coupled to a telephone line, where there are federal regulations demanding lightning protection !).

Art Unit: 2614

As per **claims 2,3**, it would have been obvious to use a well known connector type to implement the disclosed coupling of the device to the network/equipment.

As per **claims 5,6,16,17,18**, it would have been obvious to implement a known method of lighting protection, such as a fuse or capacitor (and further obvious to experiment and design an appropriate value) for the purpose of protecting the terminal.

As per **claims 7-10,19-22**, the system generates an AC current which is rectified to light the LED's if the path is unbroken.

As per **claim 11**, the tester is floating.

As per **claim 12**, it would have been obvious to implement a known telecom cable configuration, such as the standard 4-wire pair in order to couple to the network.

As per **claim 13**, there is a 3rd position of the switch where the testing circuits are disconnected.

As per **claim 14**, the tester may connect to any network device, such as a modem.

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.

As per applicant's argument that the cited prior art does not disclose that same type of indication of 'working order' as that of the claimed invention, the examiner notes the non-final 112 rejection above, and the examiner requests that applicant show where

Art Unit: 2614

the specification clearly defines what ‘working order’ would be in this situation (ie. How does the equipment functioning affect the disclosed testing circuit?).

As per applicant’s arguments that the surge protection does not protect the equipment, the examiner disagrees. Any lightning surge circuitry that fires will redirect the lightning current along a saf(er) path. When lightning protection trips in a device coupled to telephone equipment, the lightning current will be directed away from the inputs and outputs of said device. As such the lightning protection will protect any equipment coupled to said device. Further, examiner notes that there are federal regulations that require that **any** device coupled to the public phone system have lightning and power cross protection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 571-272-7498, and whose email address is alexander.jamal@uspto.gov

The examiner can usually be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone or email are unsuccessful, the examiner’s supervisor, Curtis A Kuntz can be reached on 571-272-7499.

Art Unit: 2614

The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and **571-273-8300** for After Final communications.

/Alexander Jamal/

Primary Examiner, Art Unit 2614

Examiner Alexander Jamal

July 28, 2009